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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,366	11/13/2003	Byron L. Baker	21627-0009	1420

26587 7590 02/23/2005

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EXAMINER	
WATKINS III, WILLIAM P	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/712,366	BAKER, BYRON L.	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11-13-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 4, 5, 6, 9, 10, 11, 12, 13, 16, 17, 18, 19, 20, 21, 22, 23, 24, and 25 of copending Application No. 10/723,516. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 7, 8, 14, 15, 26 and 27 of copending Application No. 10/723,516 in view of Mathes.

The claims of the '516 application are more specific than the instant generic claims and the instant generic claims are thus obvious over them. The claims of the '516 application are to the structure of the instant claims with a thickness variation between the spine and the attached segments. Mathes teaches increasing the thickness of a portion of a film meant to be torn away from an attached segment to allow a clean tearing (col. 2, lines 1-15). It would have been obvious to increase the thickness of the spine of the instant claims and thus arrive at the '516 claims in order to give a clean tear because of the teachings of Mathes. Selection of a specific thickness of film

material for a specific degree of tear resistance is taken as being within the ordinary skill of the art.

This is a provisional obviousness-type double patenting rejection.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 6, 10, 11, 12, 13, 16, are rejected under 35 U.S.C. 102(b) as being anticipated by Neely et al. (U.S. 5,722,538).

Neely teaches a label with a tear strip defined by perforations with a tab that extends beyond the edge of the strip (Figure 11). The language regarding the container in claims 1 and 10 is taken as being an intended use. The container is not taken as a positive limitation in these claims. The label of Neely is taken as being capable of this use as it has all of the positive structure of the claims.

7. Claims 2, 5, 7-9, 15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neely et al. in view of Yasuda et al. (U.S. 5,409,754).

Neely et al. teaches a label with a perforated removable central portion made of vinyl (abstract, col. 6, lines 45-55). Yasuda et al. teach a plastic label with a perforated removable central portion that can made of vinyl or polyethylene (col. 3, lines 1-15). The instant invention claims a label with a spine made of polyethylene. It would have been obvious to one of ordinary skill in the art to have used polyethylene instead of vinyl as the resin of Neely as these are taught as being equivalent materials in a similar application by Yasuda et al. Variation in the perforation size and spacing is taken as being within the ordinary skill of the art absent unexpected results as is variation in the shape of the tab. The polyethylene resin of the combination is taken as being plastically deformed when a segment is removed as it is the same material used in the instant claims.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neely et al. (U.S. 5,722,538) in view of Bacon (U.S. 5984,388).

Neely et al. teaches a label with a removable spine to seal the open end of a package sleeve (abstract). Bacon teaches use of a similar structure without an easily removable spine on a CD package in order to prevent theft and easy opening in a store without scissors col. 3, lines 10-30). The instant invention claims a label with a removable spine on a CD box. It would have been obvious to one of ordinary skill in the art to have used the label of Neely et al. on a CD box in situations where theft is not a concern of the merchant and ease of opening is desired.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on

access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WW/ww
February 22, 2005

WILLIAM P. WATKINS III
PRIMARY EXAMINER